

REMARKS

Upon entry of the present amendment, which is being filed concurrently with the filing of a Request for Continuing Application, claims 20, 27, 39, 43 and 44 will have been amended, while claims 60-63 will have been submitted for consideration by the Examiner.

In view of the herein contained amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection set forth in the Official Action of August 12, 2003. Such action is respectfully requested and is now believed to be appropriate and proper.

In the above-noted Official Action, the Examiner addressed Applicant's election of claims 20-31 and 39-49, treated the merits of Applicant's traverse and found them not persuasive. Accordingly, the Examiner indicated the requirement to be proper and made the same final. At least for reasons set forth in the above-noted traverse, Applicant again submits that the Examiner's requirement is inappropriate and respectfully requests an action on the merits of all the claims pending in the present application.

Applicant notes with appreciation the Examiner's indication that the references listed in the Information Disclosure Statement filed on March 17, 2003 have been considered. Applicant further notes that concurrently with the present Response, Applicant is filing an additional Information Disclosure Statement bringing to the attention of the Examiner several documents cited during the prosecution of corresponding European applications.

Consideration of the cited documents by return of the attached PTO-1449 Form is respectfully requested in due course.

Applicant further notes the Examiner's indication that the corrected drawings submitted on May 20, 2003 are acceptable.

Turning to the merits of the action, the Examiner rejected claims 20-23, 25, 27-31, 39-42, 44, 46-47 and 57 under 35 U.S.C. § 102(e) as being anticipated by SMITH et al. (U.S. Patent No. 6,385,655). Applicant respectfully traverses the above rejection.

In setting forth the rejection, the Examiner interpreted the dedicated server 22 of SMITH et al. as comprising the communication apparatus. However, Applicant respectfully submits that such an interpretation is inappropriate. Applicant's communication apparatus, as recited, contains many structural and functional components that render the same significantly different than a server. In this regard, Applicant notes that the server of SMITH et al. merely receives data from the sender and transmits the same to the receiver. As set forth by SMITH et al. at column 5, lines 32-38, "the dedicated server functions in accordance with such standards as for example Internet standards to manage the transfer of documents between senders and recipients". Thus, the server of SMITH et al. merely serves as a management device for transferring documents between a transmitter and a receiver. On the other hand, the communication apparatus recited in Applicant's claims includes numerous other features.

By the present Response, Applicant has defined the communication apparatus of Applicant's invention more specifically so as to even more clearly define over the server of SMITH et al. In this regard, claim 20 has been amended to recite, inter alia, a control panel that is configured to at least enter a destination address and the transmitter has been amended to recite performing of the recited operations "in response to an input from the control panel". It is respectfully submitted that the server of SMITH et al. does not include nor is there any teaching that it can be modified to include the combination of features recited in Applicant's claim 20. Accordingly, Applicant respectfully requests reconsideration of the outstanding rejection and an indication of the allowability of claim 20 in due course.

Method claim 39 has been amended to also define more specifically features that clearly distinguish the present invention from the SMITH et al. document cited by the Examiner. In particular, claim 39 has been amended to recite the entering of at least a destination address through a control panel and transmitting image data "in response to an input from the control panel". For reasons substantially similar to those set forth above with respect to claim 20, it is accordingly submitted that claim 39 is also patentable over the SMITH et al. reference cited by the Examiner.

By the present Response, Applicant has further submitted several additional claims that define additional features that even further distinguish the present invention from the SMITH et al. reference cited by the Examiner. In particular, claims 60 and 62 define

connection of an input device to the communication apparatus independently of the network connection.

In the outstanding Official Action, the Examiner further rejected claims 24, 26, 43 and 45 under 35 U.S.C. § 103 as unpatentable over SMITH et al. in view of RACHELSON (U.S. Patent No. 6,157,706). Applicant respectfully traverses the above rejection.

Initially, Applicant notes that these claims are dependent from one of shown to be allowable claims 20 and 39 and are thus allowable at least based upon the recitations of their respective base claims. Additionally, Applicant submits that these claims are patentable based on their own recitations.

In this regard, Applicant notes that the Examiner has not set forth a proper motivation for the combination of the teachings of SMITH et al. and RACHELSON. The Examiner's assertion that SMITH et al's. system "would easily be modified to include the teachings of RACHELSON" is irrelevant as far as the issue is a motivation to combine the teachings of SMITH et al. and RACHELSON. The fact that the combination or modification is "easy" does not address the crucial issue of motivation for the combination. Further, the Examiner's assertion that the systems share cumulative features also does not address the issue of motivation. Similarly, the results of the combination noted by the Examiner (more user friendly) is also not relevant to the issue of motivation. Accordingly, it is respectfully submitted that claims 24, 26, 43 and 45 are clearly patentable for this additional reason.

Additionally, Applicant notes that the RACHELSON disclosure does not provide a choice of communication types but converts e-mail to fax and fax to e-mail. Thus, the teaching thereof is remote from SMITH et al. Accordingly, Applicant respectfully requests reconsideration of each of the Examiner's rejections and an indication of the allowability of all the claims pending in the present application, in due course. Such action is respectfully requested and is now believed to be appropriate and proper.

Applicant further wishes to make of record a telephone interview conducted between Applicant's undersigned representative and Examiner Pokrzywa in charge of the present application. This interview took place on November 18, 2003 with Mr. Naoyoko Tsuchiya representing the Assignee of the present application (Panasonic Communications Co., Ltd.) being present. During the above-noted interview, Applicant's undersigned representative pointed out the significant distinctions between the server of SMITH et al. and the communication apparatus and communication method of the present application. At the conclusion of the interview, the Examiner indicated that he accepted the distinctions and that they should serve to patentably distinguish the present claims from the SMITH et al. reference subject of course to his conducting of an update search in the present application.

During the above-noted interview, the Examiner indicated that if the amendments presently submitted to claims 20 and 39 were submitted in the form of an Amendment after Final, they would constitute new issues requiring further search for consideration.

Accordingly, Applicant has submitted them concurrently with the filing of a Request for Continued Examination and submits, based on the Examiner's indication, that a first action Final Rejection is thus inappropriate.

Applicant respectfully thanks the Examiner for his courtesy and for his understanding in scheduling the above-noted interview as well as for his cooperative nature as exhibited during the above-noted interview.

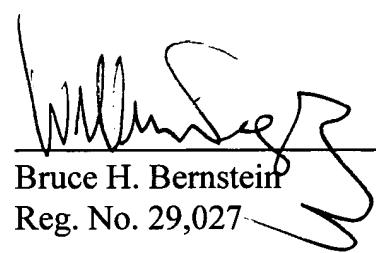
SUMMARY AND CONCLUSION

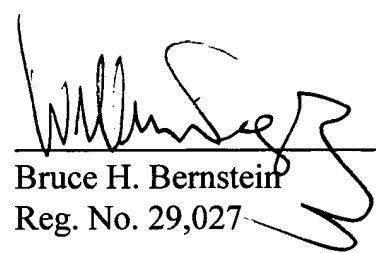
Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended several claims and has made of record a telephone interview conducted with the Examiner in charge of the present application. Applicant has discussed the references cited by the Examiner and has pointed out the substantial and significant shortcomings thereof with respect to the claims. Applicant has further discussed the recitations of the claims and has shown how the recited features are not taught, disclosed nor rendered obvious by the references cited by the Examiner. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully requests an indication to such effect in due course.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this paper, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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